



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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JUL 22, 2003

Paper No. 9

In re Application of :
William Vreeland *et al* : DECISION ON PETITION
Application No. 09/320,822 :
Filed: May 27, 1999 :
For: Razor Glide Strip :

This is a decision on the renewed petition filed on June 17, 2003 by which petitioners again request withdrawal of the holding that this application stands abandoned for failure to file a timely and proper reply to the Office letter dated January 6, 2000. No fee is required for the renewed petition.

The renewed petition is dismissed.

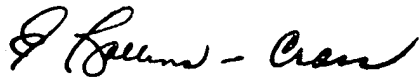
The original petition filed on March 27, 2003, paper No. 6, was dismissed as having been untimely filed under the provisions of 37 CFR 1.181(f). In the decision dated April 17, 2003, paper No. 7, it was pointed out that as a prerequisite to consideration of the merits of the petition, a terminal disclaimer would be required. It was also pointed out that the required terminal disclaimer would have to include certain specific language, and petitioners were advised to consult MPEP § 711.03(c) for the precise language which would be acceptable in the event that a renewed petition under 37 CFR 1.181 were filed.

A review of the renewed petition shows that while the renewed petition has been accompanied by a terminal disclaimer, the terminal disclaimer does not contain the language which is required pursuant to MPEP § 711.03(c). Absent a terminal disclaimer complying with the requirements of set forth in MPEP § 711.03(c), the merits of the petition cannot be reached. The relevant portion of MPEP § 711.03(c) reads (emphasis of the required language is supplied by the undersigned:

"Rather than dismiss an untimely petition to withdraw the holding of abandonment under 37 CFR 1.181(f), the Office may treat an untimely petition to withdraw the holding of abandonment on its merits on the condition that, in any design application, any utility application filed before June 8, 1995, or any plant application filed before June 8, 1995, the petition is accompanied by a terminal disclaimer dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period between the mail date of the notice of abandonment and the filing date of such petition to withdraw the holding of abandonment. See 37 CFR 1.183 (the Office may suspend or waive the requirements of 37 CFR 1.181(f), subject to such other requirements as may be imposed). The Office may treat an untimely petition to withdraw the holding of abandonment on its merits in a utility or plant application filed on or after June 8, 1995, on the condition that the petition is accompanied by a terminal disclaimer dedicating to the public a terminal part of the term of any patent granted thereon that would extend beyond the date 20 years from the filing date of the application, or the earliest application to which the application specifically refers under 35 U.S.C. 120, 121, or 365(c). In either case, the terminal disclaimer must also apply to any patent granted on any application that claims the benefit of the filing date of the application under 35 U.S.C. 120, 121, or 365(c). Such a terminal disclaimer is not required under 37 CFR 1.137(d) because abandonment of an application is a per se failure to exercise due diligence, and as such, an applicant cannot obtain patent term extension under 35 U.S.C. 154(b) due to prosecution delay caused by abandonment of the application. Where a petition to withdraw the holding of abandonment is granted, the application is considered to never have been abandoned and, as such, the prosecution delay caused by the treatment of the application as abandoned is not considered a per se failure to exercise due diligence. Thus a terminal disclaimer is required to avoid granting patent term extension under 35 U.S.C. 154(b) due to prosecution delay caused by the treatment of the application as abandoned."

The Power of Attorney and corresponding change of address attached to the renewed petition will be entered. The application is being retained in Technology Center 3700 pending the filing of a renewed petition. The renewed petition must be filed within two months of the date of this decision. See 37 CFR 1.181(f).

PETITION DISMISSED.



E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

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